

## **REMARKS**

After entry of this Amendment, claims 1, 2, 5, 6, 11 through 34, and 36 through 38 remain in the application, with claim 1 in independent form. Claims 1, 2, and 5 have been amended, claim 6 remains unchanged, claims 3, 4, and 35 have been cancelled, claims 7 through 10 remain cancelled, and claims 11 through 34 remain withdrawn. Claims 36 through 38 have been added.

### ***Claim Amendments and Comments***

Claim 1 has been amended to incorporate the elements of claims 3 and 4 in order to claim, and thereby clarify, the specific type of silicone compositions (I) and (II) employed for forming the respective first and second layers of the silicone-based adhesive sheet of the present invention. Specifically, each one of the layers is formed from a *different* hydrosilylation-curable silicone composition, with at least one of the hydrosilylation-curable silicone compositions comprising (F) a curing inhibitor component. Support for this amendment can be found in at least paragraphs [0036], [0037], [0048], [0049], [0055], and [0057] of the instant specification and in original claims 3 and 4.

Further, claim 1 has been amended to incorporate the elements of claim 35 in order to clarify differences in curing times of the hydrosilylation-curable silicone compositions (I) and (II) of the first and second layers. Specifically, the *slower* curing hydrosilylation-curable silicone composition (II) of the second layer has a curing time *at least five times greater* than that of the hydrosilylation-curable silicone composition (I) of the first layer, based on the 90% vulcanizing times of the first and second layers at 130°C as specified by JIS K 6300. Support

for this amendment can be found in at least paragraphs [0033] and [0051] of the instant specification and in original claim 35.

Further, claims 36 through 38 have been added to clarify various embodiments of the present invention. Specifically, claim 36 encompasses certain embodiments where *both* of the layers include (F) the curing inhibitor component, and the curing inhibitor components (F) are each present in different amounts for adjusting curing speed of the layers. Claim 37 encompasses certain embodiments where *both* of the layers include (F) the curing inhibitor component, and the curing inhibitor components (F) are each different in type for adjusting curing speed of the layers. Support for these amendments can be found in at least paragraph [0051] of the instant specification. Claim 38 encompasses certain embodiments where the differences in curing times of the hydrosilylation-curable silicone compositions (I) and (II) of the first and second layers are of a larger magnitude than as claimed in claim 1. Support for this amendment can be found in at least paragraph [0033] of the instant specification.

As set forth in the previous Response, the Applicants respectfully request a rejoinder of claims 11 through 34 upon the allowance of a generic linking claim. No new matter has been added in this Amendment.

***Examiner's Claim Rejections - 35 USC §102***

Claims 1, 3, and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,163,082 to Romenesko (Romenesko), claims 1 through 6 and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,932,060 to O'Brien et al. (O'Brien), claims 1 through 3, 6, and 35 stand rejected under 35 U.S.C.

§102(b) as being anticipated by U.S. Patent No. 5,324,542 to Modic (Modic) by incorporation of either U.S. Patent No. 3,457,214, U.S. Patent No. 3,436,366, or U.S. Patent No. 3,284,406 (Modic's incorporated references), and claims 1 through 3, 5, 6, and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,889,576 to Suganuma et al. (Suganuma). For convenience, Romenesko, O'Brien, Modic (and its incorporated references), and Suganuma, are herein collectively referred to as "the prior art".

Claim 1 has been amended, so the §102 rejections are now moot as described below. Specifically, Romenesko, O'Brien, Modic, or Suganuma fail to teach each and every element of claim 1, as required to properly establish anticipation under 35 U.S.C. §102(b). In addition, relative to any obviousness concerns, the prior art fails to disclose, teach, or suggest all of the elements as claimed in the instant claim 1.

To summarize, claim 1 encompasses a silicone-based adhesive sheet. As clarified in this Amendment, the silicone-based adhesive sheet comprises a first layer of a hydrosilylation-curable silicone composition and a second layer disposed adjacent to and in contact with the first layer. The second layer comprises a ***slower curing*** hydrosilylation-curable silicone composition than the first layer. In other words, the silicone-based sheet of the present invention comprises two silicone layers, with each of the silicone layers being formed from ***different*** hydrosilylation-curable silicone compositions having ***different curing speeds*** relative to each other. The aforementioned differences in curing speeds can be readily appreciated with reference to the EXAMPLES of the instant application (see, e.g. paragraphs [0081] and [0085]). Further, the aforementioned orientation of the first and second layers can be readily appreciated

with reference to the figures and specification of the instant application (see e.g. Figures 1 and 2 and paragraph [0053]).

As the Examiner is well aware, to properly establish anticipation of a claim under 35 U.S.C. §102, the reference must teach each and every element of that claim. See MPEP §2131. In addition, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” See *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

With regard to the prior art, Romenesko teaches a silicone gel or grease disposed on a substrate. A UV-curable organopolysiloxane liquid composition is coated over the silicone gel or grease and cured until converted to a solid, non-tacky state. The silicone gel can be moderately crosslinked by a hydrosilylation reaction. Therefore, at a minimum, Romenesko does not disclose, teach, or suggest a silicone-based adhesive sheet, formed from two adjacent layers that are ***each formed from different hydrosilylation-curable silicone compositions***, as claimed in the instant claim 1. In addition, Romenesko does not disclose, teach, or suggest a silicone-based adhesive sheet having two adjacent layers formed from hydrosilylation-curable silicone compositions that each has ***different curing speeds***, as claimed in the instant claim 1. Notably, the Examiner has already recognized that the Romenesko does not anticipate claim 4. Therefore, because the elements of claim 4 have been incorporated into claim 1, the Examiner can surely appreciate that Romenesko does not anticipate claim 1 as amended.

Further, Romenesko does not teach that the silicone gel and the UV-curable organopolysiloxane cure at ***different rates***. The Examiner opines that the silicone gel and the UV-curable organopolysiloxane will have different curing rates, but provides no basis for

this conclusion. With regards to this, the Applicants respectfully submit that the Examiner has **not** adhered to the standards set forth in the MPEP for establishing inherent anticipation of the claims under 35 U.S.C. §102. In particular, MPEP 2112(IV.) dictates that the Examiner must provide a rationale or evidence tending to show inherency and that in providing the rationale to show inherency, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP 2112(IV.) citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). As such, the §102 rejection over Romenesko is now overcome.

Relative to O’Brien, this reference teaches a release laminate comprising a substrate and a first layer coated on the substrate. The first layer comprises a cured silicone composition. The cured silicone composition comprises an alkenyl silicone, a hydrogen siloxane, a hydrosilylation catalyst, a cure inhibitor, and optionally, fillers and anchorage additives. A second layer contacts the first layer and comprises a silicone pressure sensitive adhesive formed by a condensation reaction. Therefore, at a minimum, O’Brien does not disclose, teach, or suggest a silicone-based adhesive sheet, formed from two adjacent layers that are ***each formed from different hydrosilylation-curable silicone compositions***, as claimed in the instant claim 1. In addition, O’Brien does not disclose, teach, or suggest a silicone-based adhesive sheet having two adjacent layers formed from hydrosilylation-

curable silicone compositions that each has ***different curing speeds***, as claimed in the instant claim 1. As such, the §102 rejection over O'Brien is now overcome.

Relative to Modic, this reference teaches a curable silicone coating composition which can be coated on a silicone layer (a "base coating material"). The curable silicone coating composition can be cured via a hydrosilylation reaction. The silicone layer can be formed from a condensation or addition curable organopolysiloxane. Applicants understand that "*addition* curable" can also be referred to in the art as "*hydrosilylation* curable"; however, at a minimum, Modic does not disclose, teach, or suggest a silicone-based adhesive sheet, formed from two adjacent layers that are ***each formed from different hydrosilylation-curable silicone compositions***, as claimed in the instant claim 1. In addition, Modic does not disclose, teach, or suggest a silicone-based adhesive sheet having two adjacent layers formed from hydrosilylation-curable silicone compositions that each has ***different curing speeds***, as claimed in the instant claim 1. Notably, the Examiner has already recognized that Modic does not anticipate claim 4. Therefore, because the elements of claim 4 have been incorporated into claim 1, the Examiner can surely appreciate that Modic does not anticipate claim 1 as amended. As such, the §102 rejection over Modic is now overcome.

Relative to Suganuma, this reference teaches a silicone rubber adhesive which is used to join silicone-coated fabrics. Suganuma further teaches that the silicone rubber constituting the adhesive and silicone-coated fabrics could be an *addition*-curable type. However, Suganuma provides no additional information for the silicone rubber constituting the silicone-coating. Therefore, at a minimum, Suganuma does not disclose, teach, or suggest a silicone-based adhesive sheet, formed from two adjacent layers that are ***each formed from***

***different hydrosilylation-curable silicone compositions***, as claimed in the instant claim 1.

In addition, Suganuma does not disclose, teach, or suggest a silicone-based adhesive sheet having two adjacent layers formed from hydrosilylation-curable silicone compositions that each has ***different curing speeds***, as claimed in the instant claim 1. Notably, the Examiner has already recognized that Suganuma (and its incorporated references) does not anticipate claim 4. Therefore, because the elements of claim 4 have been incorporated into claim 1, the Examiner can surely appreciate that Suganuma does not anticipate claim 1 as amended. As such, the §102 rejection over Suganuma is now overcome.

In view of the foregoing, the Applicants respectfully submit that claim 1 as amended is novel over the prior art, and therefore, all of the §102(b) rejections are overcome. Specifically, at a minimum, each one of the references relied upon by the Examiner to establish the rejections in the instant Office Action, fails to disclose, teach, or even suggest a silicone adhesive sheet having two silicone layers disposed adjacent and in contact with one another as claimed in the present application. In addition, each one of the references relied upon by the Examiner to establish the rejections in the instant Office Action fails to disclose, teach, or even suggest a silicone adhesive sheet formed from ***different hydrosilylation-curable*** silicone compositions having ***different curing speeds*** as claimed in the present application. Further, it is clear that no 35 U.S.C. §103 rejection would be proper in view of the teachings of any of the references relied upon by the Examiner to establish the §102(b) rejections in the instant Office Action.

***Examiner's Claim Interpretations and Rejections - 35 USC §103***

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Suganuma. However, because claim 4 has been incorporated into claim 1 as amended, and because claim 1 has been further amended to claim additional features of the silicone compositions used to form the first and second layers, the Applicants respectfully submit that this rejection is now overcome.

In view of the foregoing, the Applicants respectfully submit that claim 1 is both novel and non-obvious in view of the disclosure, teachings, and suggestions of the prior art such that claim 1 as amended, as well as the claims that depend therefrom, is in condition for allowance. If any additional fees are necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys, P.C..

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

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Date

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